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Paper No. 7

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OFFICE OF PETITIONS

In re Patent No. 5,623,978	:	
Issued: April 29, 1997	:	DECISION ON PETITION
Application No. 08/688,692	:	
Filed: July 29, 1996	:	
For: STUMP CUTTING DOUBLE CLAW	:	
TOOTH STRUCTURE	:	

This is in response to the petition under 37 CFR 1.378(b), filed June 11, 2012, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.¹

The patent issued April 29, 1997. The grace period for paying the second maintenance fee expired on April 30, 2005.

The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable and if the surcharge required by § 1.20(i)(1) is paid as a condition of accepting payment of the maintenance fee. 37 CFR 1.378(a).

A petition under 37 CFR 1.378(b) to accept late payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed

¹ The Office notes that the patent expired for patentee's failure to pay both the second and third maintenance fees.

promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them.

Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

The USPTO finance records reveal that the Office received only a \$200.00 fee on June 22, 2012 for the payment of the second maintenance fee and surcharge. The current small entity amount for the maintenance fee due at 7.5 years as set forth in 37 CFR 1.20(f) is \$1,425.00.

Additionally, the current amount for the surcharge after expiration where the late payment is unavoidable as set forth in 37 CFR 1.20(i)(1) is \$700.00. As the full amount of these fees has not been paid, the petition will not be treated on the merits until petitioner submits a "renewed" petition under 37 CFR 1.378(b), accompanied by the payment of the \$1,450.00 maintenance fee and the balance due for the surcharge in the amount of \$500.00 (\$700.00 - \$200.00 previously paid on June 22, 2012). Thus, the petition is dismissed. The proper petition form is enclosed for petitioner's convenience. Petitioner must submit the maintenance fee and surcharge in the amount due on the date the "renewed" petition is filed and the maintenance fee and surcharge are paid.

The Office reminds petitioner that under the statutes and regulations, the USPTO has no duty to notify a patent owner of the requirement to pay maintenance fees or to notify the patentee when the maintenance fee is due. While the Office mails maintenance fee reminders strictly as a courtesy, it is solely the responsibility of the patent owner to ensure that the maintenance fee is paid timely to prevent expiration of the patent. The failure to receive a maintenance fee reminder (or Notice of Patent Expiration) does not relieve the patentee of the obligation to timely pay the maintenance fee, nor will it constitute unavoidable delay if the patentee seeks reinstatement under the regulation. See Rydeen v. Quigg, 748 F. Supp. 900, 905 (D.D.C. 1990) (holding that failure to pay maintenance fee because patentee's attorney had not received customary notice from PTO alerting him it was due was not sufficient to establish unavoidable delay because PTO has no duty to provide notice that maintenance fee is due). A patentee who is required by 35 U.S.C. 41(c)(1) to pay a maintenance fee within 7 years and six months of the patent grant or face expiration of the patent, is not entitled to any notice beyond that provided by publication of the statute. See Rydeen, 748 F. Supp. at 906.

Moreover, the fact that a patentee may have been preoccupied with other matters does not excuse the delay in payment of a maintenance fee. A showing of diligence is essential to support a finding of unavoidable delay. There is no "sliding scale" based upon the priority given to maintaining this patent in force, or more diligently seeking reinstatement, *vis-à-vis* other matters. The issue is solely whether the maintenance, or reinstatement, of the patent at issue was conducted with the

care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. See Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F. 2d 533 (D.C. Cir. 1982) (holding that where applicant's attorney missed deadline because he was preoccupied with other legal matters and was in the process of moving his residence, applicant did not establish unavoidable delay).

It is noted the address given on the petition differs from the address of record; however, there is no indication in the patent file that petitioner filed a change of address in this case. If the patent owner desires to receive future correspondence regarding this patent, the appropriate change of correspondence address must be submitted. The appropriate form is enclosed. As a one-time courtesy, the Office will mail a copy of this communication to petitioner. Thereafter, the Office will continue to send correspondence to the address of record until otherwise notified.

The application file is being forwarded to Files Repository.

Inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

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Enclosures: Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent and Change of Correspondence Address

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